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09/833,654	04/13/2001	Kenneth E. Gillespie	3782-3	1749

7590 12/02/2005  
Kenneth E. Gillespie  
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EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,654

Applicant(s)

GILLESPIE, KENNETH E.

Examiner

Nga B. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on November 11, 2004, which paper has been placed of record in the file.
2. Claims 1-21 are pending in this application.

### ***Response to Arguments/Amendment***

#### **3. *Claim Rejections - 35 USC § 101***

Applicant's amendments with respect to claims 1-21 have been considered but are persuasive. Applicant amends the claims to overcome the **35 USC § 101** rejection, therefore, examiner decides to withdraw **35 USC § 101** rejection regarding to claims 1-21.

#### **4. *Claim Rejections - 35 USC § 102 and § 35 USC 103***

Applicant's arguments with respect to claims 1-21 have been considered but are not persuasive.

In response to applicant's arguments that all of the references cited by the examiner do not teach each and every element of the present invention, it is noted that in the previous office action, examiner pointed out the references cited by the examiner (Egendorf, U.S. Patent No. 5,794,221; Colvin, Sr. (hereinafter Colvin), U.S. Patent No. 5,825,881; and Kuo, U.S. Patent Application Publication No. 2003/0120615) teach every element in the claimed invention (also see details below).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In conclusion, for the reasons set forth above, examiner decides to maintain the previous **35 USC § 102 and 35 USC § 103** rejections and make this office action FINAL.

5. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Egendorf, U.S. Patent No. 5,794,221.

Regarding to claim 4, Egendorf discloses a method of making charges for goods and/or services against the account of a payment card having an associated account number, including paying a provider of goods and/or services (column 5, lines 1-10; column 6, lines 13-36), without supplying the account number to the provider of said goods and services (column 5, lines 39-42).

8. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Colvin, Sr. (hereinafter Colvin), U.S. Patent No. 5,825,881.

Regarding to claim 5, Colvin discloses a method of providing transactions while providing uniqueness for each transaction, including relying on transactional identifying system generated by combining providers' identification numbers with their internal invoice numbers for each transaction (column 5, lines 37-48 and column 6, lines 52-58;

combining the merchant's account number with the purchaser order number for each transaction).

9. Claims 1-3, 6-12, 14-17, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuo, U.S. Patent Application Publication No. 2003/0120615.

Regarding to claim 1, Kuo discloses a method of performing a financial transaction involving at least: (a) a provider of goods or services, (b) a purchaser of said goods or services, and (c) at least one further entity (figure 1, paragraph [0054], Merchant 2b, Consumer 1b, Host 3), the purchaser using a credit card having a credit card identifier associated therewith to effect a purchase of said goods or services (paragraph [0014], the consumer using payment card having a card number associated therewith), the method including:

performing at least one transaction between the provider and the purchaser (paragraph [0058], consumer 1b initiates the online transaction by sending an order to a merchant 2b);

associating at least one identifier different from the credit card identifier with said transaction (paragraph [0059], merchant 2b generates an orderID, not card number, with the transaction; [0016]-[0018], consumer does not need to submit card number in this online transaction process);

communicating the transaction identifier but not the credit card identifier from the purchaser to the further entity over the Internet (paragraph [0060], consumer sends a payment authorization request 6a includes the orderID to the Host 3);

associating the transaction identifier to the purchaser's credit card identifier (paragraph [0065], Host 3 associates the orderID with the card number),

whereby the credit card issuer charges the purchaser's credit card based at least in part on the associated credit card identifier (paragraph [0065], the credit card issuer charges the consumer's payment card based on the card number).

Regarding to claim 2, Kuo discloses including transmitting the purchaser's credit card identifier over a private connection (paragraphs [0065], [0070], [0008], the Host 3 sends card number to the card issuer over Internet Payment Gateway or payment clearing network, which is a private payment network).

Regarding to claim 3, Kuo discloses wherein the communicating step includes transmitting pieces of information at different times to different locations (paragraphs [0060], merchant sends the order accepted response message 5a to the consumer, the consumer sends the payment authorization request 6a to the Host 3; [0061], merchant sends the payment approval request 7 to the Host).

Regarding to claim 6, Kuo discloses a method of conducting payment transactions between consumer and merchant comprising:

generating a transaction identifier associated with and identifying a transaction between the consumer and the merchant (paragraph [0059], merchant 2b generates an orderID, not card number, with the transaction);

communicating said transaction identifier in lieu of the consumer's credit

card account identifier (paragraph [0060], consumer sends a payment authorization request 6a includes the orderID to the Host 3; [0016]-[0018], consumer does not need to submit card number in this online transaction process);

authenticating said communicated transaction identifier and those who transmit it (paragraph [0065], the Host use the key pair, authorization code and authentication code included in the payment authorization request 6a transmitted by the consumer to locate the consumer payment card data);

associating the transaction identifier with the consumer's credit card account (paragraph [0065], Host 3 associates the orderID with the card number); and

effecting payment from the consumer to the merchant through use of said consumer's credit card account (paragraph [0070], the payment card issuer effects payment from the consumer to the merchant through the use of consumer's payment card account).

Regarding to claim 7, Kuo discloses wherein the consumer communicates the transaction identifier (paragraph [0060], consumer sends a payment authorization request 6a includes the orderID to the Host 3).

Regarding to claim 8, Kuo discloses wherein said merchant generates said transaction identifier and communicates it to a third party transaction facilitator.

Regarding to claim 9, Kuo discloses wherein said third party transaction facilitator comprises a clearinghouse (paragraph [0070], payment card clearing network).



Regarding to claim 10, Kuo discloses wherein said third party transaction facilitator comprises the issuer of said consumer's credit card account (paragraph [0070], the consumer's payment card issuer).

Regarding to claim 11, Kuo discloses wherein said communicating step comprises communicating said transaction identifier over the Internet (paragraph [0056]).

Regarding to claim 12, Kuo discloses wherein said authenticating step is based on a consumer passcode (paragraph [0055], the key pair, authentication code and authentication code are established by the payment card owner consumer with the Host).

Regarding to claim 14, Kuo discloses wherein said associating step is performed based on a database lookup (paragraph [0063]).

Regarding to claim 15, Kuo discloses the method further including the steps of:  
combining the transaction identifier and consumer's personal identifier (paragraph [0060], the payment authorization request 6a includes the orderID, the consumer's payment authorization code and consumer's authentication code);

subjecting the combined transaction identifier and consumer's personal identifier to an undisclosed mathematical procedure (paragraph [0014], all messages sending and passing over the Internet are SSL channel encrypted, thus the payment authorization request 6a is encrypted); and

transmitting the result of said procedure, wherein the authenticating step is based at least in part on the transmitted result (paragraph [0014], all messages received are decrypted by recipients).

Regarding to claim 16, Kuo discloses a system for conducting secure payment transactions between consumer and merchant comprising:

equipment at the merchant that generates a transaction identifier associated with and identifying a transaction between the consumer and the merchant and communicates said transaction identifier to a transaction facilitator in lieu of the consumer's credit card account identifier (paragraph [0059], the Merchant server 2a generates an orderID included in the transaction; [0061], the Merchant Server transmit the payment approval request 7 includes the orderID to the Host 3; [0018], merchant does not handle consumer's card number in this online transaction process);

equipment at the transaction facilitator that authenticates said communicated transaction identifier and associates the transaction identifier with the consumer's credit card account (paragraphs [0055] and [0065], Host 3 containing computer servers that authenticates the orderID and associates the orderID with the consumer's payment card account); and

payment fulfillment equipment that effects payment from the consumer to the merchant through use of said consumer's credit card account (paragraph [0070], Internet Payment Gateway or payment card clearing network).

Regarding to claim 17, Kuo discloses wherein said merchant uses a web server to generate said transaction identifier and communicate it to the transaction facilitator (paragraph [0059], the Merchant server 2a).

Regarding to claim 19, Kuo discloses wherein said merchant uses an electronic cash register to generate said transaction identifier (paragraph [0059], the Merchant

server 2a, which is equivalent to an electronic cash register, generates an orderID included in the transaction).

Regarding to claim 20, Kuo discloses wherein said transaction facilitator includes a secure database that maps transaction identifiers and consumer passcodes into credit card account authorizations (paragraphs [0055] and [0065]).

### ***Claim Rejections 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 13, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo, U.S. Patent Application Publication No. 2003/0120615.

Regarding to claims 13, 21, Kuo does not disclose wherein said authenticating step is based on a digital signature and certificates. However, authenticating step is based on a digital signature and certificate is well known in the art. A digital signature is an electronic signature that can be used to authenticate the identity of the sender of a message or the signer of a document, and possibly to ensure that the original content of the message or document that has been sent is unchanged. A digital certificate is an electronic "credit card" that establishes your credentials when doing business or other transactions on the Web. It is issued by a certification authority (CA). It contains your

name, a serial number, expiration dates, a copy of the certificate holder's public key (used for encrypting messages and digital signature), and the digital signature of the certificate-issuing authority so that a recipient can verify that the certificate is real.

Today, many electronic commerce entities authenticate the consumers based on the digital signature and certificate in order to ensure the security in the electronic transaction. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Kuo's to include the feature above for the purpose of improving the security in the electronic transaction.

Regarding to claim 18, Kuo discloses wherein said transaction facilitator includes a web server (paragraph [0055], Host 3 containing computer servers). Kuo does not disclose a firewall and an offline computer coupled to the web server through the firewall. However, an offline computer coupled to the web server through the firewall is well known in the art. Firewall is a system designed to prevent unauthorized access to or from a private network. Firewalls can be implemented in both hardware and software, or a combination of both. Firewalls are frequently used to prevent unauthorized Internet users from accessing private networks connected to the Internet, especially *intranets*. All messages entering or leaving the intranet pass through the firewall, which examines each message and blocks those that do not meet the specified security criteria. Today, most of electronic commerce entity's having a web server connected to one or more offline computers (private network) through the firewall in order to prevent unauthorized Internet users from accessing their private networks. Therefore, it would have been obvious to one with ordinary skill in the art at

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the time the invention was made to modify Kuo's to include the feature above for the purpose of improving the security in the Internet environment.

***Conclusion***

12. Claims 1-21 are rejected.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
C/o Technology Center 3600  
Washington, DC 20231

Or faxed to:

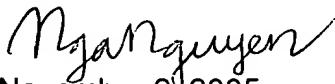
(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label  
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany  
Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen

  
November 9, 2005